THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL VINEL

Appeal No. 94-4401
Application 07/791,305[1]

HEARD: February 8, 1996

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR RECONSIDERATION

Appellant requests that we reconsider our decision of February 21, 1996 wherein we affirmed the examiner's decision rejecting claims 5 through 10 under 35 U.S.C. § 103.

[1] Application for patent filed November 14, 1991.

Appellant first contends that our decision was not clear with regard to what rejection has been affirmed.

Page 3 of our decision makes it clear that the examiner's rejection was of claims 5 through 10 under 35 U.S.C. § 103 over the combination of Chao, Dravida and Pearson. The last page of our decision makes it clear that it was this decision of the examiner. i.e., the rejection of claims 5 through 10 under 35 U.S.C. § 103 over Chao, Dravida and Pearson, which was affirmed.

Although we relied on the teaching of Pearson, alone, in reaching our decision, any relevant teachings of Chao and Dravida being merely cumulative thereto, this application of the references to the claims in a manner somewhat different than the examiner's application does not constitute a new ground of rejection contrary to appellant's contention to the contrary. See In re Halley, 296 F.2d 774, 132 USPQ 16 (CCPA 1961); In re Bush, 296 F.2d 491, 496, 131 USPQ 263, 266-267 (CCPA 1961).

Appellant contends that we have "not fully given separate consideration to the claims as grouped by appellant" [page 3 of the Request for Reconsideration]. However, arguments not made are waived. In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642 (Fed. Cir. 1986). Further, 37 CFR 1.192 (7) requires that the claims stand or fall together unless the brief contains a statement to the contrary (which appellant has provided) AND appellant explains why the claims of a group are believed to be separately patentable (which, except for dependent claims 7 and 10, appellant has not done). Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. Since claims 7 and 10 were argued as to

their merits, on pages 16-17 of the principal brief, we did treat these claims separately, at pages 6-7 of our decision of February 21, 1996.

With regard to Pearson, appellant argues [page 6 of the Request for Reconsideration] that the idle packets do not include control information "and these are not control cells in the sense of the present invention and claim 5." We agree with appellant that the idle packets of Pearson are not the same as the control cells of the disclosed present invention. However, as explained in our decision, at pages 4-5, the Pearson disclosure would have made the subject matter of claim 5 obvious within the meaning of 35 U.S.C. § 103 because the artisan would have recognized that the detection of empty cells, as broadly claimed, is no different from the detection, by Pearson, of a lack of transmitted data for a predetermined period of time. Just as appellant replaces this empty cell with a control cell, Pearson replaces the detection of a lack of data for a predetermined period of time with an idle packet which is really a control cell, as claimed.

Appellant argues that Pearson is inapplicable to the instant claimed invention since Pearson is not directed to an ATM (asynchronous time-division multiplex cell transmission link). However, appellant offers no evidence as to why the communication system of Pearson is not applicable to ATM systems. We hold that the skilled artisan would have been led to employ Pearson's technique for detecting transmission errors in any data communication system, including

ATM systems as claimed by appellant. Further, since we rely on Pearson, alone, as the basis for affirming the examiner's decision, appellant's arguments at pages 7-8 of the Request for Reconsideration would appear to be moot.

Appellant's argument, at pages 8-9 of the Request for Reconsideration, regarding the "control" information of the instant invention not being the type of "control" information disclosed by Pearson, is unpersuasive for the reasons set forth on pages 4-6 of our decision and we find no reason to repeat our comments here. Suffice it to say that Pearson's idle packets do comprise "control" information, as broadly claimed.

Appellant further argues that Pearson does not detect empty cells as required by claim 5. However, as explained in our decision, the detection, by Pearson, of a lack of communication for a predetermined period of time is analogous to the detection of empty cells and we simply disagree with appellant on this point. While we recognize the difference between appellant's disclosed invention and that disclosed by Pearson, we hold the instant claimed invention, as broadly set forth, to have been obvious over Pearson.

We have considered appellant's arguments relative to claims 7 and 10 on pages 12-14 of the Request for Reconsideration but find them unpersuasive for the reasons given at page 7 of our

decision of February 21, 1996. Appellant's arguments are not commensurate with the broad scope of the claims.

We have granted appellant's request to the extent that we have reconsidered our decision of February 21, 1996 but the request is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

RECONSIDERATION
DENIED

ERROL A. KRASS )
Administrative Patent Judge )
)
)
JERRY SMITH ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS
) AND
) INTERFERENCES
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MICHAEL R. FLEMING )
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